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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/519,302 | 01/25/2005 | Morten Gregaard | PATRADE | 9171 |
| 7590 | 03/14/2006 | | EXAMINER | |
| James C Wray Suite 300 1493 Chain Bridge Road McLean, VA 22101 | | | GIBSON, RANDY W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2841 | |

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/519,302 | GREGAARD ET AL. | |
| | Examiner | Art Unit | |
| | Randy W. Gibson | 2841 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 1-7, 10 and 11 is/are rejected.
 7) Claim(s) 8 and 9 is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 27 December 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 3/10/05.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 10 March 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (Not all of the foreign references submitted by the applicant are listed on the PCT search report.). It has been placed in the application file, but at least some of the references referred to therein have not been considered.

Claim Objections

2. Claims 2-4 and 9 are objected to because of the following informalities: (i) In claims 2-4, the phrase "preferably" renders each of the claims indefinite because it is unclear whether the limitation following this phrase are part of the claimed invention (See **MPEP** § 2173.05(d)); and, (ii) With regards to claim 9, the phrase "the dispensing unit" lacks positive antecedent basis (**MPEP** § 2173.05(e)).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Warnke (DE 4,446,345 A1). As noted in the PCT search report, Warnke discloses an apparatus for registering weight and/or water content comprising of a measuring cell made of two adjustably spaced conductive plates (2a,2b) that have that are disposed with mutually opposed faces (Fig. 1) to form a capacitor 2 (Fig. 2) so that a well defined part of the individual (a leg in Figure 1) may be placed in-between so that a measuring unit (5,6) may display the result. With respect to claim 5, Figure 3 seems to show a measuring bridge. With respect to claim 6, elements 5 & 6 seem to be the MCU unit (microprocessor) with data store (ROM, RAM) and a display (A visual display for the user is inherently necessary in order for the device to be operative.).

5. Claims 1, 2, 4, 6, 7, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearlman (US # 5,810,742). Pearlman discloses an apparatus for registering weight and/or water content comprising of a measuring cell made of two conductive plates (22,24) that are adjustably spaced (Col. 7, lines 17-25) and that have that are disposed with mutually opposed faces (Fig. 2) to form a capacitor (Col. 19, lines 21-46) so that a well defined part of the individual (a breast) may be placed in-between so that a measuring unit (14) may display the result.

With respect to claim 2, which calls for the plates to be made of a metal alloy, one embodiment describes the conductive plates being formed of Silver Chloride (Col. 9, lines 15-21) and Aluminum in another embodiment (Col. 12, lines 35-38).

With respect to claim 4, the backing for the electrodes are formed of plastic (Col. 8, lines 54-56).

With respect to claims 6 & 7, the controller of Pearlman is disclosed as being a computer, which inherently consists of a MCU (microprocessor) and data storage (ROM, RAM).

With respect to claim 10, since the measuring device of Pearlman is disclosed as being controlled by a PC, then it has an “add-on board” (PC board) for his measuring unit which allows at least one measuring unit to interface with the computer (Col. 13, lines 14-18, for example).

6. Claims 1, 6-8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanita Corp (EP 1091215 A2). See the PCT search report for details.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Warnke (DE 4,446,345 A1). Regarding claim 2, it is unclear from the PCT search report if the plates 2a,2b are made from a metal alloy (like copper). However, the cross-hatching of these two plates in Figure 1 seems to indicate metal. If not inherently present, the examiner takes official notice that conductive plates in a capacitor, or for that matter any conductor in any electrical device, would usually be made of a metal such as copper -- since copper alloys have good electrical properties, are easy to shape, are anti-bacterial, and are relatively cheap (As is well known, pure copper, as opposed to a copper alloy, is not normally used in electrical devices since pure copper would corrode (oxidize) and it's electrical properties will change accordingly causing the circuit to be in constant need of re-calibration as the plates degrade upon exposure to air, moisture, & salt. The copper would have to be blended (alloyed) with an anti-corrosive agent (zinc, tin or nickel, for example) to be useful in a real world device. See

<<http://www.schoolscience.co.uk/content/4/chemistry/copper/copch0pg5.html>>.).

If not inherently present already, it would have been obvious to the ordinary practitioner to manufacture the conductive plates of Warnke from some type of metal alloy, preferably copper, motivated by its art recognized suitability for it's intended use. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) (Claims to a printing ink comprising a solvent having the vapor pressure characteristics of butyl carbitol so that the ink would not dry at room temperature but would dry quickly upon heating were held invalid over a reference teaching a printing ink made with a

different solvent that was nonvolatile at room temperature but highly volatile when heated in view of an article which taught the desired boiling point and vapor pressure characteristics of a solvent for printing inks and a catalog teaching the boiling point and vapor pressure characteristics of butyl carbitol. "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); and, **MPEP** § 2144.07.

9. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Warnke (DE 4,446,345 A1). It is unclear from the PCT search report if Warnke shows a dispenser unit, preferably for dispensing food, drugs, or water, in the immediate vicinity of the electric plates. However, the examiner takes official notice that doctor's offices normally have drinking fountains and/or bathrooms (sinks) somewhere in the facility for dispensing water; doctor's offices often have vending machines for dispensing gum, snacks, drinks, or over-the-counter medications (aspirin) as well. It is unclear what "immediate vicinity" means, since this is a relative term; the examiner believes that anywhere in the building, or at least anywhere on the same floor of the same building, could be reasonably considered in the "vicinity" of the measuring unit. If not inherently present, than it would have been

obvious to place a “dispensing unit” somewhere in the doctor’s office complex motivated by the convenience of the patient.

10. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Warnke (DE 4,446,345 A1). Regarding claim 4, it is unclear from the PCT search report if the plates 2a,2b are coated with an electrically insulative (non-conductive) material such as plastic. It seems logical that the plates 2a,2b would need to be coated with an insulator to prevent the patient from being shocked from accidental contact; additionally, the plates would need to be insulated from each other or else they would no longer form a capacitor (And accidental contact, or just proximity if there is not an insulative coating thereon, between two oppositely charged plates would cause a spark discharge between the plates which could potentially damage the entire control circuitry with the resulting surge of current.). If not inherently present already, it would have been obvious to the ordinary practitioner to coat the conductive plates of Warnke with an insulative material for safety’s sake. See **MPEP** § 2144.03.

It is not clear if the word “plastic” is part of the claimed limitations or not (see claim objections, *supra*), but if so, the examiner takes official notice that plastics (I.E.: organic compounds produced by polymerization) are commonly used insulative materials in electrical devices (such as the plastic coating on copper wires); it would have been obvious to the ordinary practitioner to use a plastic coating as an insulator motivated by its art recognized suitability for it’s intended use. See **MPEP** § 2144.07.

11. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Warnke (DE 4,446,345 A1). Warnke does not expressly disclose the limitation of an "external weight unit". However, the examiner notes that almost all doctor's offices have a weighing scale located somewhere in the office to measure the patient's weight (The claim simply calls for an "external weight unit"; it does not specify that the scale be connected to the electrode measuring unit in any way.). If not inherently present already, it would have been obvious to the ordinary practitioner to place a bathroom scale in the doctor's office motivated by a desire to obtain basic health data about a patient.

Conclusion

12. Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (571) 272-2103. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Randy W. Gibson
Primary Examiner
Art Unit 2841